

# PATENT COOPERATION TREATY

# PCT


## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

REC'D 24 FEB 2005

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Applicant's or agent's file reference TSL1821PCT		<b>FOR FURTHER ACTION</b>		See Form PCT/IPEA/416
International application No. PCT/JP2004/004562		International filing date (day/month/year) 30.03.2004		Priority date (day/month/year) 31.03.2003
International Patent Classification (IPC) or national classification and IPC C07F7/18				
Applicant DOW CORNING TORAY SILICONE CO. LTD.				
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 4 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> sent to the applicant and to the International Bureau a total of sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>				
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input checked="" type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>				
Date of submission of the demand  29.10.2004		Date of completion of this report  23.02.2005		
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465		Authorized Officer  Elliott, A  Telephone No. +49 89 2399-8218		



**INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY**

International application No.  
PCT/JP2004/004562

**Box No. I Basis of the report**

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
  - ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
    - ☐ international search (under Rules 12.3 and 23.1(b))
    - ☐ publication of the international application (under Rule 12.4)
    - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements\*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

**Description, Pages**

1-14 as originally filed

**Claims, Numbers**

1-10 as originally filed

**Drawings, Sheets**

1/1 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. ☐ The amendments have resulted in the cancellation of:
  - ☐ the description, pages
  - ☐ the claims, Nos.
  - ☐ the drawings, sheets/figs
  - ☐ the sequence listing (*specify*):
  - ☐ any table(s) related to sequence listing (*specify*):
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
  - ☐ the description, pages
  - ☐ the claims, Nos.
  - ☐ the drawings, sheets/figs
  - ☐ the sequence listing (*specify*):
  - ☐ any table(s) related to sequence listing (*specify*):

\* If item 4 applies, some or all of these sheets may be marked "superseded."

**INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY**

International application No.  
PCT/JP2004/004562

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**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

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1. Statement

Novelty (N)	Yes: Claims	1,3,4,7-10
	No: Claims	2,5,6
Inventive step (IS)	Yes: Claims	1,3,4,7,9
	No: Claims	2,5,6,8,10
Industrial applicability (IA)	Yes: Claims	1-10
	No: Claims	-

2. Citations and explanations (Rule 70.7):

**see separate sheet**

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**Box No. VII Certain defects in the international application**

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The following defects in the form or contents of the international application have been noted:

**see separate sheet**

**INTERNATIONAL PRELIMINARY  
REPORT ON PATENTABILITY  
(SEPARATE SHEET)**

International application No.

PCT/JP2004/004562

The following documents are mentioned in this opinion:

- D1: US-A-4 026 880 (MITCHELL TYRONE D) 31 May 1977 (1977-05-31)
- D2: US-A-4 209 455 (PEPE ENRICO J) 24 June 1980 (1980-06-24)
- D3: US-A-3 033 815 (PIKE RONALD M ET AL) 8 May 1962 (1962-05-08)
- D4: GB 882 051 A (UNION CARBIDE CORP) 8 November 1961 (1961-11-08)
- D5: GB-A-1 394 206 (GEN ELECTRIC) 14 May 1975 (1975-05-14)

**Re Item V.**

The subject-matter of claims 2, 5, and 6 is not to be seen as novel with respect to document D1 as D1 discloses the compound containing the piperidine ring in column 5, line 15. The manufacture of this compound is given in the same column. The subject-matter of claims 2, 5, 6, 8 and 10 is additionally not to be regarded as inventive with respect to D1 as the compounds of D1 can be used as glass sizing agents, i.e. as agents for treating the surface of glass. The disclosure of D1 goes beyond the one novelty-destroying compound mentioned above and includes a generic disclosure of further compounds falling under the scope of claim 2 whose preparation falls under the scope of claims 5 and 6.

With respect to D2 (cited in the description) which discloses compounds similar in structure to those presently-claimed but differing by their containing a secondary nitrogen instead of a tertiary nitrogen. The examples of the present application clearly show that compounds with a tertiary nitrogen are superior to those with the secondary nitrogen where adhesive strength is concerned. Claims 1, 3, 4, 7 and 9 are to be regarded as novel and inventive over the prior art.

(D3-D5 disclose compounds similar to those presently on file.)

**Re Item VII.**

Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in document D1 and possibly also D3-D5 has not been mentioned in the description, nor have these documents been identified therein.